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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,823	07/11/2001	Avi Ashkenazi	10466/87	1376
35489	7590	11/28/2003	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP			KAUFMAN, CLAIRE M	
275 MIDDLEFIELD ROAD			ART UNIT	
MENLO PARK, CO 94025-3506			PAPER NUMBER	

1646

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/903,823	Applicant(s) ASHKENAZI ET AL.	
	Examiner Claire M. Kaufman	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 14 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 39-46 and 49-51.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

CONTINUATION OF ADVISORY ACTION PTOL-303:

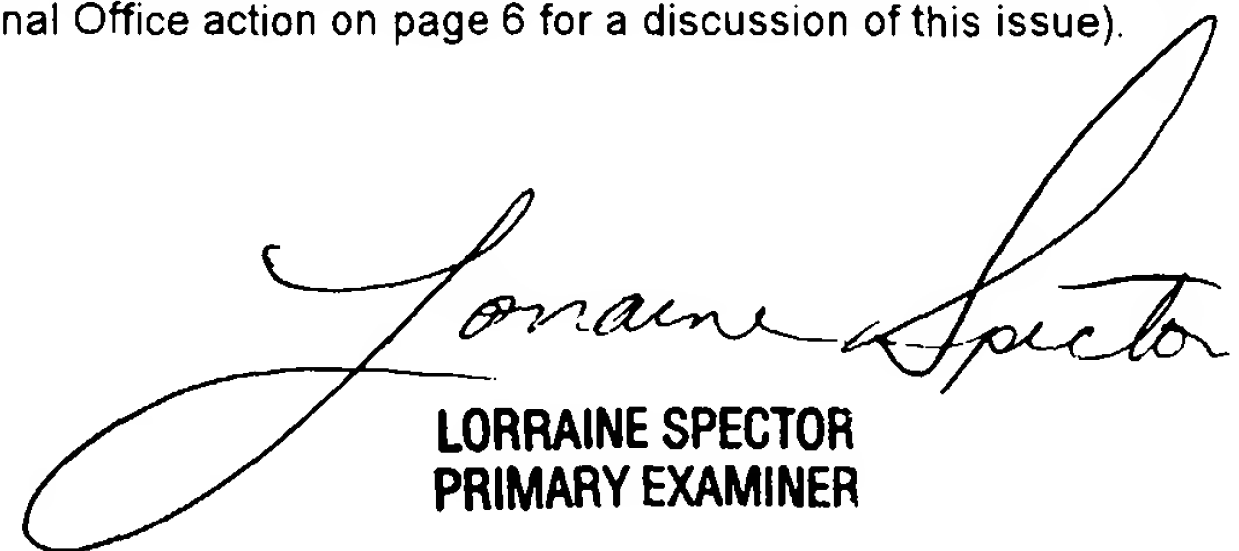
Continuation of #2: The proposed amendment will not be entered because it raises new issues associated with the proposed amendment requiring the encoding nucleic acid be amplified in lung tumors. New issues include those under 35 USC 112, first and second paragraphs.

Continuation of #5:

In the response to the final Office action, Applicants say on page 4 that a Declaration by Avi Ashkenazi was enclosed with the amendment after final. No Declaration by Ashkenazi was enclosed nor is the enclosure of the Declaration mentioned on Applicants Transmittal sheet submitted with the response and amendment after final.

In response to Applicants' arguments addressing the rejection under 35 USC 101/112, the specification provides no identification of the chromosome to which the nucleic acid encoding PRO339 maps. Testing for chromosomal aneuploidy is an invitation for further experimentation. Also, there is no evidence that clinicians use information about a gene product not being overexpressed as a basis for deciding to not treat a patient with an agent that targets that gene product. This is a hypothetical utility not disclosed in the specification. As to evidentiary standard, since there is no control for aneuploidy, it is maintained that the skilled artisan cannot reasonably conclude that a gene product is overexpressed, particularly when the level of overexpression was detected at only 2-3 fold.

The rejections under 35 USC 102 and 103 are maintained because even though Applicants argue that the effective filing date of the instant application should be the February 11, 2000, filing date of the PCT in which the polypeptides were first disclosed, it is maintained that Applicants are not entitled to this date for prior art priority purposes due to the inability to use the claimed invention in the instant application and necessarily the priority applications as well (see the final Office action on page 6 for a discussion of this issue).



LORRAINE SPECTOR
PRIMARY EXAMINER